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In the Supreme Court of the United States

OCTOBER TERM, 1948 49

No. ~~185.~~ 2

GRAVER TANK & MFG. CO., INC.,
THE LINCOLN ELECTRIC COMPANY,
GRAVER TANK & MFG. CORPORATION,
Petitioners,

vs.

THE LINDE AIR PRODUCTS COMPANY,
Respondent.

ON WRIT OF CERTIORARI TO COURT OF APPEALS
FOR SEVENTH CIRCUIT.

PETITIONERS' REPLY IN SUPPORT OF PETITION FOR REHEARING.

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May 5, 1949.

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Case.

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Respondent's belated "Answer to Petition for Rehearing" urges that the judgment of infringement of claims 18, 20, 22 and 23 be not reexamined.

But it should be.

1. Issue of Infringement Has Been Decided under Misapprehension.

The question is, can these claims be expanded to cover manganese silicate?

This Court affirmed the judgment of infringement because it mistakenly supposed the judgment rested upon a finding of fact, and, therefore, was not matter for this Court to reexamine.

But that is not the basis on which the judgment of infringement rests. The trial court found infringement by reading specifications as claims (R. 920). In this manner

manganese silicate was written into the claims of the patent (R. 920, Finding 13, R. 925). Thus the Court has held that claims unambiguously limited to "alkaline earth metal silicates" may be broadened by reference to the specifications to include a composition the Court has found is *not* an alkaline earth metal silicate (Finding 12, R. 925).

Such resort to the specification was clear error of law. This Court so held in overthrowing claims 24 and 26 (Slip opinion, p. 6, 336 U. S. 271 at p. 277). Manifestly, if a claim cannot be *narrowed* in order to save it by resort to the specifications, it cannot, by that process, be *expanded* to cover a composition found not to be within its terms.

It follows that there can be no infringement so long as it remains law that the claims measure the grant. The Court failed to carry that conclusion into judgment on the infringement issue, as the opinion shows, only because it mistakenly supposed it was dealing with an issue of fact.

2. Rule Applied to Find Infringement Enlarges Patent to Cover Results.

Respondent, however, says the trial court found manganese silicate the equivalent of the "alkaline earth metal silicates" on which the patent issued.

What the trial court found was that "*in welding operation*" they are equivalent (Finding 21, R. 926); they are substantially identical "*in operation and in result*" (Finding 20, R. 926). The sole predicate of the holding of infringement is that as the trial court read the patent "the fact that manganese is a proper substitute for calcium silicate * * * is fully disclosed *in the specification*" (R. 920). This was not a finding of equivalency on disputed evidence, as respondent hints. It was an expansion of the claims by resort to the specification.

It should be noted further that the attempt to expand claims to cover other compositions producing the same

result is forbidden by *Halliburton Oil Well Cementing Co. v. Walker* (1946), 329 U. S. 1, 9, and many other cases. Especially is this so when to give the claims so broad a reading is to sweep into the patent other compositions, known and unknown, patented and unpatented. If manganese silicate is to be picked from the list of nine in the specifications, and read into the claims, so also must the other eight, including Robinoff's aluminum silicate. See petitioners' opening brief on the merits, pp. 57-67.

The claims as written, and now held valid, protect the Unionmelt 20 flux on which respondent's success is based (R. 908, Finding 9, R. 925). But by affirming the judgment of infringement the Court has expanded these claims, by resort to the specifications, to cover compounds not within the terms thereof. This, the Court held, may not be done. (Slip opinion, p. 6, 336 U. S. 271, at p. 277.)

3. Affirmance of Trial Court's Reading of Prior Miller Grants It to Jones.

Respondent's argument that Lincoln's manganese silicate was derived from the patent underscores the trial court's further error of law on the infringement issue.

Although "the primary object" of the prior and now expired Miller patent, No. 1,754,566 (Defts' Exh. 145, R. 969) was to provide:

> "a blanket of molten manganese silicate" (see Miller patent, R. 969, col. 1, lines 43-45),

the trial court held that the Jones patent in suit, if construed to cover manganese silicate, was not anticipated by Miller.

Why?

Because Jones required the constituents to be "prefused or reacted" (R. 921) whereas Miller, although disclosing the use of prefused manganese silicate—which is what Lincoln used—pointed out that:

> "Instead of preformed [that is, prefused] manganese silicate the coating may contain material adapted to react at the temperature of the metal-depositing operation to produce manganese silicate. This is the preferred form of the invention *as it permits one operation to be dispensed with*" (R. 921, see also Miller patent, R. 969, col. 2, lines 65-70).

Whether Lincoln in following the disclosure, although not the *preferred* form, of the prior Miller, can be branded an infringer of Jones, is a pure question of law. What the trial court overlooked was Lincoln's right, irrespective of such indicated preference on the part of Miller, to utilize the preformed manganese silicate which Miller clearly taught the world. And to affirm the trial court's erroneous conclusion, as this Court did in the mistaken belief it was dealing with a question of fact, is to withdraw Miller from the public domain and add it to Jones.

CONCLUSION.

The infringement issue, as the opinion shows, has been decided under misapprehension. Rehearing, therefore, should be granted, or, in the alternative, the judgment corrected by reversing the judgment of infringement in accordance with the legal principles already declared in the Court's opinion.

Respectfully submitted,

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